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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,072	08/28/2001	David Goodman	**19-0088	5656

23377 7590 05/11/2010
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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

MAIL DATE	DELIVERY MODE
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05/11/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/941,072	Applicant(s) GOODMAN ET AL.	
	Examiner Etienne P. LeRoux	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Status

Claims 1-4 and 6-43 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 15 is rejected under 35 U.S.C. 102(e) as being anticipated by Enari (US 6,747,998).

Regarding claim 15, Enari discloses:

accepting at least one search parameter from a set, the set comprising: file size, file author, and file type; [Enari, col 6, lines 25-30, CD order sent to dealer including title name of artist, time, genre]

generating a query based on the search parameters;

[Enari, col 6, lines 25-30, CD order sent to dealer including title name of artist, time, genre]

accepting a record returned in response to the query generated;

[Enari, col 6, lines 30-35, CDs are stored in the warehouse]

determining a label corresponding to the record [Enari, col 6, lines 35-40, inputs information related to CD media necessary for search for stock control, col 6, lines 15-20, bar-code printers]

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determining an external storage medium, the label being fixed to an external portion of the external storage medium [Enari, Fig 11, bar-code printer 128 and bar-code reader 127]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-19 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enari and further in view of Koenck et al (US 6,749,122)..

Regarding claim 16, 36, Enari discloses the elements of the claimed invention as noted above but does not disclose wherein the label is a machine-readable label, the method further comprising: accepting information read from the machine-readable label; and determining that the accepted information read from the machine-readable label matches information associated with the record; and generating a first indicator, said first indicator able to be perceived by humans.

Koenck discloses wherein the label is a machine-readable label, the method further comprising: accepting information read from the machine-readable label; and determining that the accepted information read from the machine-readable label matches information associated with the record; and generating a first indicator, said first indicator able to be perceived by humans [Koenck, col 28, lines 60-65]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Enari to include wherein the label is a machine-readable label, the method further comprising: accepting information read from the machine-

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readable label; and determining that the accepted information read from the machine-readable label matches information associated with the record; and generating a first indicator, said first indicator able to be perceived by humans as taught by Koenck for the purpose of providing a quick and easy confirmation to the user as is well-known and expected in the art. .

Regarding claim 17, 37, the combination of Enari and Koenck discloses the elements of the claimed invention as noted above but does not disclose determining that the accepted information read from the machine-readable label does not match information associated with the record and generating a second indicator, said second indicator able to be perceived by humans. However, Koenck discloses the above limitation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Enari and Koenck to include determining that the accepted information read from the machine-readable label does not match information associated with the record and generating a second indicator, said second indicator able to be perceived by humans for the purpose of providing a quick and easy indication to the user.

Regarding claim 18, 38, the combination of Enari and Koenck discloses wherein the first indicator is a first audible sound, and the second indicator is a second audible sound as argued above.

Regarding claim 19, 39, the combination of Enari and Koenck discloses the elements of the claimed invention as noted above but does not disclose wherein the label includes a human readable part, and wherein the information associated with the record corresponds to the human-readable part of the label. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include wherein

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the label includes a human readable part, and wherein the information associated with the record corresponds to the human-readable part of the label because human-readable labels are well-known and expected in the art for the purpose of quick and easy identification of an object.

Claims 1-4, 6-14, 20-35 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ottesen et al (US 6,222,697) in view of Sun et al (US 6,239,934) and further in view of Enari (US 6,747,998) and further in view of Rothberg et al (US 6,412,083).

Regarding claim 1, 20, 32, 33, 35, 40, 41, 42, 43, Ottesen discloses:

determining that the storage medium has not been assigned a first label, the first label uniquely identifying the storage medium [Ottesen, col 3, line 50 – col 4, line 10]

Ottesen discloses the elements of the claimed invention as noted above but does not disclose a second label. Sun discloses a second label [Sun, Fig 7B-1, bar code label 115, col 5, lines 35-50]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ottesen to include a second label as taught by Sun for the purpose of identifying the disk and/or the contents of the disk [Sun, col 5, lines 45-50]. The ordinarily skilled artisan would have been motivated to combine Ottesen and Sun because they both teach identifying a disk/disk drive by means of a bar-code.

The combination of Ottesen and Sun discloses writing the first label to a storage portion of the storage medium [Ottesen, col 5, lines 15-40 and Figs 2-4, DINUM 30,]

The combination of Ottesen and Sun discloses the elements of the claimed invention as noted above but does not disclose providing a command to generate the second label based on the first label. Enari discloses providing a command to generate the second label [Enari, col 6, lines 15-

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25, Fig 11, barcode printer 128]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include providing a command to generate the second label for the purpose of producing a bar-code label to be attached to an outside surface of the storage medium. The ordinarily skilled artisan would have been motivated to combine the teachings of Ottesen and Sun with the teaching of Enari because the above references disclose one or more bar-code labels for a storage medium.

The combination of Ottesen, Sun and Enari discloses the second label based on the first label [Ottesen, col 4, lines 5-10, Sun, col 5, lines 45-50].

The combination of Ottesen, Sun and Enari disclose the second label to be associated with an external portion of the storage medium [Sun, Fig 7B-1, bar code label 115, col 5, lines 35-50]

The combination of Ottesen, Sun and Enari disclose the elements of the claimed invention as noted above but does not disclose updating a database with an association between each file stored on the storage medium. Rothberg disclose updating a database with an association between each file stored on the storage medium [Rothberg, col 5, lines 20-40, Fig 3]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include updating a database with an association between each file stored on the storage medium as taught by Rothberg for the purpose of tracking the files on the storage medium by means of a directory [Rothberg, col 5, lines 20-40, Fig 3]. The ordinarily skilled artisan would have been motivated to combine Rothberg with the combination of Ottesen, Sun and Enari because Ottesen discloses a computer database of defects on a disk using the DINUM or Disk Identification Number [col 4, lines 1-10] and Rothberg discloses a directory of files on the disk [col 5, lines 20-40].

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The combination of Ottesen, Sun, Enari and Rothberg discloses and a value associated with the first label [Ottesen, col 3, line 50 – col 4, line 10, col 5, lines 15-40].

The combination of Ottesen, Sun, Enari and Rothberg discloses in response to determining that a first file contained on the storage medium has been deleted, updating the database to reflect that the first file has been deleted [Rothberg, col 5, lines 20-40, Fig 3, step 330]

Regarding claim 2, 21, 34, the combination of Ottesen, Sun, Enari and Rothberg discloses wherein the database is stored on a first device, further comprising: synchronizing the database with a second database stored on a second device [Rothberg, col 5, lines 20-40, Fig 3, Enari, Fig 11, 127]

Regarding claim 3, 22, the combination of Ottesen, Sun, Enari and Rothberg discloses wherein the first device is a personal computer and the second device is a handheld device [Rothberg, col 5, lines 20-40, Fig 3, Enari, Fig 11, 127].

Regarding claim 4, 23, the combination of Ottesen, Sun, Enari and Rothberg discloses wherein the second device is an untethered handheld device [Rothberg, col 5, lines 20-40, Fig 3, Enari, Fig 11, 127].

Regarding claim 6, 25, the combination of Ottesen, Sun, Enari and Rothberg discloses wherein the unique ~~storage medium~~ second label is a bar code label [Sun, Fig 7B-1, bar code label 115, col 5, lines 35-50]

Regarding claim 7, 26, the combination of Ottesen, Sun, Enari and Rothberg discloses determining the first label based, on state information accessible to a device upon which the database is stored [Ottesen, col 3, line 50 – col 4, line 10].

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Regarding claim 8, 27, the combination of Ottesen, Sun, Enari and Rothberg discloses wherein the state information is a count sequence [Ottesen, col 3, line 50 – col 4, line 10].

Regarding claim 9, 28, the combination of Ottesen, Sun, Enari and Rothberg discloses the elements of the claimed invention as noted above but does not disclose wherein the database includes

records, each record including a first field having a value associated with the first label, and a second field having a value associated with a file stored on the storage medium. However, Rothberg discloses a directory of files stored on a storage medium [col 5, lines 20-40]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include wherein the database includes records, each record including a first field having a value associated with the first label, and a second field having a value associated with a file stored on the storage medium because creating a table in a database is well-known and expected in the art.

Regarding claim 10, 29, the combination of Ottesen, Sun, Enari and Rothberg discloses the elements of the claimed invention as noted above but does not disclose accepting information read from a label associated with the storage medium without reading the storage medium; converting the accepted information into a database key; requesting records from a database instance using the database key; accepting records in response to the request; and rendering information about the accepted records. However, Enari discloses a bar-code reader [Enari, Fig 11]. It would have been obvious to one of ordinary skill in the art to modify the above combination of references to include accepting information read from a label associated with the storage medium without reading the storage medium; converting the accepted information into a

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database key; requesting records from a database instance using the database key; accepting records in response to the request; and rendering information about the accepted records because the operation of a bar-code reader is well-known and expected in the art.

Regarding claim 11, 30, the combination of Ottesen, Sun, Enari and Rothberg discloses wherein the unique second label is a bar code and wherein the information read from the second label is accepted from a bar code scanner [Enari, Fig 11]

Regarding claim 12, 31, the combination of Ottesen, Sun, Enari and Rothberg discloses wherein the information about the accepted records rendered includes file names [Rothberg, col 5, lines 20-40].

Regarding claim 13, the combination of Ottesen, Sun, Enari and Rothberg discloses wherein the accepted information read from the unique second label is read by a handheld device, and the information about the accepted records is rendered on the handheld device [Enari, Fig 11]

Regarding claim 14, the combination of Ottesen, Sun, Enari and Rothberg discloses the elements of the claimed invention as noted above but does not disclose wherein the read label is converted into a database key by the handheld device, the records are requested from a database instance using the database key by the handheld device, and the records are accepted in response to the request by the handheld device. Enari discloses operation of a bar-code reader [Fig 11] and Rothberg discloses a file directory [col 5, lines 20-40]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include wherein the read label is converted into a database key by the handheld device, the records are requested from a database instance using the database key by the

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handheld device, and the records are accepted in response to the request by the handheld device because the operation of bar-code reader is well-known and expected in the art.

Regarding claim 24, the combination of Ottesen, Sun, Enari and Rothberg discloses wherein the means for reading files from and/or writing files to a removable storage medium are at least one of a floppy disk drive, a CD ROM drive, a ZIP drive, and a DVD drive [Fig 1].

Response to Arguments

Applicant's arguments filed 3/1/2010 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday through Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Etienne P LeRoux/
Primary Examiner, Art Unit 2161

5/6/2010